

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office, Commissioner for Patents, via the EFS pursuant to 37 CFR § 1.8.

/James A. Collins/

James A. Collins, Reg. No. 43,557

October 12, 2010

Date of Signature & Date of Transmission

Attorney Docket No. 12654/33

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

In re Application of:	Alan R. Bauer et al.	)	
		)	Examiner: Teresa S. Woods
		)	
Serial Number:	10/764,076	)	Group Art Unit: 3686
		)	
Title:	Monitoring system for determining and communicating a cost of insurance	)	Conf. No.: 7997

**REQUEST TO WITHDRAW FINALITY OF REJECTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Examiner:

Applicants respectfully request the finality of the August 18, 2010 Office Action be withdrawn for two reasons. First, the Official Action misstates the claim of priority. Second, the Official Action introduces new grounds of rejection not necessitated by an Amendment nor based on information submitted in an information disclosure statement.

## **REASONING**

### **I. Right of Priority**

#### **Request for Withdrawal of the Finality of the Office Action**

The pending Application claims priority to three earlier filed utility applications. The Application contains no claim to the Provisional Application recited in the Official Action (OA). OA, paper # 20100809 at pg. 2.

The independent claims of the pending application are entitled to the benefit of *at least* U.S. Pat. No. 6,868,386, ('386) because the pending application contains a specific reference to the '386 application, was filed before the '386 issued, and is supported by the prior application's written description as shown in Applicants' June 9, 2010, response.

Because the Official Action misstates the Application's claim of priority, fails to consider the facts presented, and fails to respond to Applicants' remarks, the outstanding Office Action is improper. For this reason, Applicants respectfully request the finality of the Office Action be withdrawn.

### **II. Double Patenting**

#### **Request for Withdrawal of the Finality of the Office Action**

An Office Action shall not be made final when a new ground of rejection is introduced that is neither necessitated by Applicants' amendment of the claims nor based on information submitted in an information disclosure statement. MPEP § 706.07(a). The Non-Final Office Action mailed December 23, 2009, did not include non-statutory double patenting claim rejections. The pending Final Office Action introduces two double patenting rejections against several claims. The claims are un-amended and the double patenting rejections are not based on references cited in an information disclosure statement. Because of these facts, the finality of the Office Action is premature for this reason too. *See* MPEP § 706.07(a).

Since the pending OA is providing new grounds of rejection, Applicants respectfully request the finality of the Office Action be withdrawn.

### III. Conclusion

In view of these reasons, Applicants respectfully submit that the finality of the pending action is premature. If any issues remain, Applicants request that Examiner call the undersigned to expedite the prosecution of the application.

Respectfully submitted,

/James A. Collins/

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200

---

James A. Collins  
Registration No. 43,557  
Attorney for Applicants